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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91228154
Party	Plaintiff TAQKEY SCIENCE CO., LTD.
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Date	07/27/2016
Attachments	Opposition to Applicant_s Motion to Amend Application ALFJ006.001ZTUS.pdf(33919 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Taqkey Science Co., Ltd.)	Opposition No. 91228154
)	
Opposer,)	
)	
v.)	
)	
Bio-Helix Co., Ltd.,)	
)	
Applicant.)	
)	

OPPOSITION TO APPLICANT’S MOTION TO AMEND APPLICATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Pursuant to T.M.B.P. § 514.03, Opposer, Taqkey Science Co., Ltd. (hereinafter “Opposer”), hereby opposes the Motion to Amend U.S. Application Serial No. 86/721236 filed by Applicant, Bio-Helix Co., Ltd. (hereinafter “Applicant”), and requests that the Trademark Trial and Appeal Board (the “Board”) deny Applicant’s Motion to Amend. In the event that the Board does not deny Applicant’s Motion to Amend, Opposer requests that the Board defer a determination on the motion until a final decision in this matter. Opposer also requests that the Board suspend the Opposition proceeding pending a determination on Applicant’s Motion to Amend and then reset all deadlines, including, but not limited to, the deadline for the parties to conduct the mandatory discovery conference, once the Board issues a decision.

STATEMENT OF FACTS

1. On or about August 11, 2015 Applicant filed an application with the U.S. Patent and Trademark

Office seeking to register the mark  in connection with Nucleic acid for

laboratory use, namely, DNA molecular weight ladders; Prestained protein molecular weight ladders; Stains, and tracking dyes for electrophoresis; Reagents for preparative electrophoresis; Biochemicals for electrophoretic blotting; Reagents for biochemical imaging and analysis; Gels, namely, protein gels and agarose gels; Reagents and chemicals for medical and scientific research use, namely, reagents for amplifying nucleic acid; Reagents, chemicals used for nucleic acid purification, amplification and detection, chemical standards, chemicals for biochemical assays, immunoassay; Biochemical reagents commonly known as probes, for detecting and analyzing molecules in protein or nucleotide arrays, namely, stains and tracking dyes for electrophoresis; Biochemical reagents used for non-medical purposes; Electrophoresis gels other than for medical or veterinary purposes; Protein in raw material form for scientific and medical research, namely, prestained protein molecular weight ladders; Nucleic acid for laboratory use in Class 1; Diagnostic preparations for medical and veterinary use, namely, nucleic acid amplification mix/kit, PCR mix/kit; Diagnostic biomarker reagents for medical purposes, namely, DNA molecular weight ladders; Reagents and chemicals for clinical, medical, and diagnostic uses; Diagnostic biomarker reagents for medical purposes; Diagnostic reagents for medicinal use in Class 5 and Electrophoresis imaging instruments; Gel documentation instruments; Computerized biochemical imaging instruments and densitometers; Computer programs for biochemical imaging and analysis; Preparative electrophoresis instrument; Blotting cells and membranes for electrophoretic transfer and for biochemical laboratory quality; Apparatus and instruments for electrophoresis and mass spectrometry; Electrophoresis apparatus not for medical purposes; Scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings therefore, namely, electrophoresis imaging instruments, gel documentation instruments in Class 9 (“Applicant’s Application”).

2. The U.S. Patent and Trademark Office assigned Applicant’s Application Serial No. 86/721236.
3. In Applicant’s Application as filed, Applicant claimed under penalty of perjury, a date of first use and first use in commerce of “at least as early as 01/07/2000.”

4. During the prosecution of Applicant's Application, Applicant amended the goods in Classes 1 and 5 to Nucleic acid for laboratory use, namely, DNA molecular weight ladders; Prestained protein molecular weight ladders comprising nucleic acid for laboratory use; Stains and tracking dyes for electrophoresis for scientific and research purposes; Reagents for preparative electrophoresis for scientific and research purposes; Biochemicals for electrophoretic blotting for scientific and research purposes; Reagents for biochemical imaging and analysis for scientific and research purposes; Gels, namely, protein gels and agarose gels for scientific and research purposes; Reagents and chemicals for medical and scientific research use, namely, reagents for amplifying nucleic acid; Reagents and chemicals used for nucleic acid purification, amplification and detection, chemical standards, chemicals for biochemical assays, and immunoassay all for scientific and research purposes; Biochemical reagents commonly known as probes, for detecting and analyzing molecules in protein or nucleotide arrays, namely, stains and tracking dyes for electrophoresis for scientific and research purposes; Biochemical reagents used for non-medical purposes; Electrophoresis gels other than for medical or veterinary purposes; Protein in raw material form for scientific and medical research, namely, prestained protein molecular weight ladders; Nucleic acid for laboratory use in Class 1; Diagnostic preparations for medical and veterinary use, namely, nucleic acid amplification mix/kit, PCR mix/kit; Diagnostic biomarker reagents for medical purposes, namely, DNA molecular weight ladders; Reagents and chemical reagents for clinical, medical, and diagnostic uses; Diagnostic biomarker reagents for medical purposes; Diagnostic reagents for medicinal use in Class 5, but reiterated the date of first use and first uses in commerce of "[a]t least as early as 01/07/2000."
5. Following the filing of the above-referenced Opposition proceeding, a proceeding in which priority of use is at issue, Applicant has filed a Motion to Amend its dates of first use and first use in commerce in Applicant's Application.

ARGUMENTS

Opposer notes that Applicant's Motion to Amend should be denied because it is not supported by the required affidavit or declaration. Mason Engineering & Design Corp. v. Mateson Chemical Corp. ("Mason"), 225 USPQ 956, 957 n.4 (TTAB 1985) (amendment to dates of use not supported by affidavit or declaration); See also 37 C.F.R. §2.20; 37 C.F.R. §2.71(c).

In the alternative, if the Board does not deny Applicant's Motion to Amend, Opposer submits that the Board has repeatedly held that where, as here, a motion to amend is made without the opposer's consent, it will defer determination of such a pre-trial motion to amend until a final decision on the case has been rendered. See Enbridge Inc. v. Excelerate Energy L.P., 92 USPQ2d 1537, 1539 n.3 (TTAB 2009) (motion to amend identification of goods and dates of use deferred until final hearing; Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990) (motion to amend identification of goods deferred); Fort Howard Paper Co. v. C.V. Gambina Inc. ("Fort Howard") 4 USPQ2d 1552 (TTAB 1987) (motion to amend dates of use deferred); and Mason, supra 225 USPQ 956, 957 n.4 (TTAB 1985) (motion to amend identification of goods deferred). See also T.B.M.P. § 514.03; Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991).

Likewise, in the instant case, the issue of priority of use will be a central focus of the case at hand. As such, and consistent with the Board's prior holdings in the Fort Howard and Mason and the other cases cited above, it is respectfully submitted that further consideration of the Applicant's motion should be denied or at least deferred pending the outcome of the case at hand.

CONCLUSION

In light of the foregoing, Opposer requests that Applicant's Motion to Amend be denied. In the alternative, Opposer requests that a determination on Applicant's Motion to Amend be deferred. Opposer also requests that the Board suspend the Opposition proceeding pending a determination on Applicant's Motion to Amend and reset all deadlines, including, but not limited to, the deadline for the parties to

conduct the mandatory discovery conference, once the Board issues a decision on Applicant's Motion to Amend.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 27, 2016

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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **OPPOSITION TO APPLICANT'S MOTION TO AMEND APPLICATION** upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid on July 27, 2016 addressed as follows:

STEVEN M. RABIN
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Sarah Beno Couvillion